

REMARKS/ARGUMENTS

Status of the Prosecution:

Claims 11, 13, 14, 16, 17 and 22-30 are presently pending and under examination.

A final rejection was issued on November 5, 2003 and a Notice of Appeal was timely filed. A Request for Continued Examination is being filed herewith. Claim 30 is canceled herein without prejudice. Claims 11, 25 and 27 are amended herein.

The requirements of 35 U.S.C. § 112, first paragraph have been satisfied

Claims 11, 13, 14, 17, 22-27, and 29-30 stand rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement.

The claims have been amended and are now directed to the maize 10kDa zein, which is adequately described in the specification. Accordingly, the grounds of the rejection are moot. Applicants respectfully request reconsideration and withdrawal of the rejection

Claims 11, 13, 14, 17, 22-27, and 29 stand rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the enablement requirement. The specification enables the maize 10kDa delta zein gene. The claims have been amended and are now directed to the 10kDa zein gene. As such, the grounds of the rejection are moot.

Reconsideration is respectfully requested along with withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

The application as filed contains adequate written description support for “saturation levels” of 10kDa zein.

Claims 11, 13, 14, 16, 17 and 22-24 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly lacking written description support for the claim limitation “saturation levels” with respect to the 10 kDa zeins. The Office Action alleges that there is no written description support for producing “saturation levels” of any 10 kDa zein. Applicants respectfully traverse this rejection and point the examiner to the disclosure at page 19, lines 7-16 *et seq.* See, for example, lines 7- 12 wherein it is stated that “All these data indicate that, by removing the negative dominance of *dzt1* and by changing promoter strength of gene copy number we find a *saturation of protein levels in the seed*. The *saturation levels of the*

10-kDa protein are of important consequence for manipulating corn seed for industrial purposes. . . .”

Accordingly Applicants submit that this new matter rejection should be withdrawn as improper. Applicants respectfully request withdrawal of the rejection on that grounds.

The claims are patentable over Bagga *et al.* in view of Hirt *et al.*

Claims 11, 17, 22-25 and 29-30 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Bagga *et al.* in view of Hirt *et al.* The Office Action notes that because the claims were directed to corn plants without regard to the *dzt1* allele they contain, that the plants taught by Bagga *et al.* therefore can be used to make the *prima facie* case. Applicants respectfully traverse this rejection. Claims 11 and 25 have been amended to include a limitation that the plants have a *dzt1* negative dominant allele, thus obviating the grounds of the rejection for these claims and the claims dependent thereon. Applicants respectfully request reconsideration and in view of the amendments, and withdrawal of the rejection under 35 U.S.C. § 103(a) over Bagga in view of Hirt..

The claims are patentable over Kirihara *et al.* in combination with Russell *et al.* and Hirt *et al.*

Claims 11, 13, 14, 17, 22-27 and 29-30 stand rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over Kirihara *et al.* in combination with Russell *et al.* and Hirt *et al.*

Applicants respectfully traverse. The references cited do not teach each and every element of the claims as amended, regardless of how they are combined, and thus the *prima facie* case is overcome. For example, the claims as amended contain a limitation to “a plant with a *dzt1* negative dominant allelic composition. None of the references individually nor in combination teach this limitation, either expressly or inherently. If the references do not teach each and every limitation of the claims, they cannot render the claims obvious. Thus the grounds of the rejection are obviated by the amendment. Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) in view of Kirihara *et al.* in combination with Russell *et al.* and Hirt *et al.*

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**PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116**

The objection to claim 28 is moot.

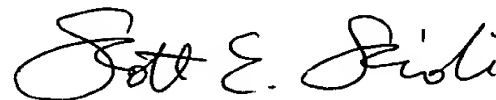
Claim 28 has been objected to as allowable if rewritten in independent form. The amendments presented herein are believed to place the claims in allowable condition, and accordingly Applicants respectfully submit that the grounds of the objection are moot. Withdrawal of same is respectfully requested.

Conclusion

This amendment is fully responsive to all outstanding issues and places all claims in condition for allowance. An early and favorable Notice to that end is earnestly sought. To resolve any remaining questions prior to the allowance of the claims, the examiner is invited to contact the Applicant's undersigned representative by telephone at 215-557-5986.

Respectfully submitted,

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